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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,459	08/14/2000	Steve Mattis	10001761-1	9534

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Hewlett Packard Company
Intellectual Property Administration
PO Box 272400
Fort Collins, CO 80528-9599

EXAMINER

VU, VIET DUY

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,459

Applicant(s)

MATTIS ET AL.

Examiner

Viet Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004 and 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-18 is/are rejected.
- 7) ☒ Claim(s) 2,3,19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The text of 35 USC 103(a) not cited here can be found in the previous office action.

2. Claims 1 and 4-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pollack, U.S. pat. No. 6,505,236 in view of Luzeski et al, U.S. pat. No. 6,430,177.

Pollack discloses a method and system for delivery email messages to users comprising:

a) determining if an electronic mail containing a large attachment prior to transmission of the message from a sender (mail portal) (see Pollack's fig. 2, step 102),

b) transmitting the email message to the intended recipient if the email message does not content a large attachment (Pollack's col 4, lines 3-13),

c) storing the attachment in a network storage if the email contains a large attachment (see Pollack's fig. 2, step 106),

d) generating a second email message for sending to the intended recipient, the second message containing a URL to the network storage site (see Pollack's col 5, lines 28-67).

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Pollack also teaches that the email message could contain just the large attachment only (see Pollack's col 4, lines 6-7 and 44-45).

Pollack does not teach using a predetermined a data set size threshold to decide whether to store email message with large attachment in the network storage. Luzeski discloses a messaging system for routing smaller email messages, i.e. smaller than a predetermined threshold, via conventional emails and larger email message with large attachment via a network storage (see Luzeski's col 6, lines 42-62). It is noted that the size of the message is determined based upon the size to the attachment or container.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Luzeski's data size threshold in Pollack because it would have enabled practicing Pollack's email delivery with large multimedia messages.

Per claims 11-12, Pollack also teaches allowing sending/forwarding the email message with large attachment to many recipients simultaneously (see Pollack's col 6, lines 11-16).

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Per claims 14-17, it would have been obvious to one skilled in the art to utilize a known document digitizer to convert a document, e.g., fax, into an electronic format for delivery via email message (see Luzeski's col 6, lines 21-40).

Allowable Subject Matter:

3. Claims 2-3 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment:

4. Applicant's arguments filed on 2/23/04 with respect to claims 1 and 4-18 have been fully considered but they are moot in view of new ground of rejection set forth above.

Conclusion:

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on (703) 305-8498.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



VIET D. VU
PRIMARY EXAMINER

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4/14/04